

Environ 6-19-03

6/17/2003
APPEAL
BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: Petkovsek EXAMINER: M. Henderson
SERIAL NO.: 09/487,696 GROUP ART UNIT: 3722
FILING DATE: January 19, 2000 ATTY. DOCKET NO.: USA-P-99-011
INVENTION: "SPECIAL SERVICE MAILING ASSEMBLY WITH LABEL
TRACKING AREA AND RECEIPT AND A METHOD OF PREPARING
A MAILPIECE FOR DELIVERY"

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Commissioner for Patents
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APPELLANT'S APPEAL BRIEF

SIR:

This Appeal Brief is submitted in support of the Notice of Appeal filed on April 7, 2003. The Appeal was taken from the Final Rejection dated December 31, 2002.

I. REAL PARTY IN INTEREST

Glenn Petkovsek is the real party in interest as the inventor of this application. No assignment has been filed or recorded in the U.S. Patent Office regarding ownership interest of this application.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant or Appellant's legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-16 and 21 are pending in this patent application. A copy of the claims is appended hereto as the Appendix. Claims 17-20 were withdrawn from consideration. Claims 9-16 and 21 have been allowed. Claim 21 was amended after Final Rejection to overcome the rejection under 35 U.S.C. §103(a) and is now in allowable form. Claims 1-8 were finally rejected by the Patent Office in a final rejection dated December 31, 2002 and are hereby on appeal. The Final Rejection is appended hereto as Exhibit A of the Supplemental Appendix.

IV. STATUS OF AMENDMENTS

All amendments have been entered in this patent application. An amendment to the claims was made after the Final Rejection. More specifically, Claim 21 was amended in an amendment after Final Rejection. The amendment to Claim 21 was entered by the Patent Office to place Claim 21 in condition for allowance.

V. SUMMARY OF INVENTION

The present invention provides a mailing form for the non-domestic delivery of a mailpiece, particularly envelopes and folders, wherein the form includes both a dispatch notice and customs declarations forms. In addition, the present invention provides a method for preparing a mailpiece for non-domestic delivery wherein a see-through envelope is affixed to the mailpiece and the corresponding customs forms and dispatch notice are

contained therein for how domestic delivery of the mailpiece by the special service. (Page 3, lines 1-11)

A mailing form 400 may include the sub-parts: two customs declarations 302a, 302b and the dispatch notice 304. The two customs declarations may be two identical copies of PS form 2976-A. The dispatch notice may correspond to PS-Form 2976-A. The mailing form 400 may provide for the sub-parts 302a, 302b and 304 to be arranged so that the dispatch notice 304 may be disposed on an edge of the mailing form 400 leaving a relatively large section 402 on the mailing form 400. The section 402 may be removable from the mailing form 400 via tear lines 324 and 404. The section 402 may contain information to aid in the delivery of the mailpiece by the special service. (Page 21, lines 29-33 and page 22, lines 1-9)

A frontside view of a backing sheet 450 may be disposed on the backside of the mailing form 400. The backing sheet 450 may have two sections 452, 454 that are separable from each other via a tear line 456. The section 452 may have an area 458 of adhesive that may adhere to a backside of the blank section 402 of the mailing form 400. The entire area 458 may remain attached to the blank section 402 and be separated from the backing sheet 450 and the mailing form 400 via the tear lines 456, 460, 324 and 404. The section 402 and the area 458 attached to the section 402 via the adhesive 450 may be discarded following their removal. Alternatively, the section 402 may be peeled from the area 458 and

used as an auxiliary label. A second area 462 of the backing sheet 450 may be detached from the section 454 and the area 458 via tear lines 456 and 460 and discarded. The dispatch notice 304 and the section 402 may overlay with the second area 462 and the area 458, respectively, of the section 452. (Page 22, lines 10-28)

The section 454 may contain an adhesive 464 between a portion of the section 454 and the mailing form 400. The adhesive 464 may hold the section 454 to the mailing form 400 until the mailing form 400 is removed from the backing sheet 450. Upon removal of the mailing form 400 from the backing sheet 450, the adhesive 464 may remain with the section 454. The section 454 may be removed from the section 452 via the tear line 456 and attached to a mailpiece 466. The adhesive 464 may provide a seal on all four sides of the section 454 when the section 454 is attached to the mailpiece 466 and may form a compartment 468. A slit 470 may be provided in the section 454 to permit entry into the compartment 468. The two customs declarations forms 302a, 302b and the dispatch notice 304 may be slipped inside the compartment 468 through the slit 470 to remain while the mailpiece 466 is non-domestically delivered. The slit 470 also may allow the customs declarations forms 302a, 302b and/or the dispatch notice 304 to be removed from the compartment 468 at various times throughout the delivery of the mailpiece 466, if necessary. The backing sheet 450 may be see-through to provide

a visual access to the inside of the compartment 468 through the section 454. (Page 22, lines 29-33 and page 23, lines 1-19)

VI. ISSUES

1. Would Claims 1-7 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention over *Main* (U.S. Patent No. 5,618,064) in view of *Petkovsek* (U.S. Patent No. 5,918,802). See *Main* (U.S. Patent No. 5,618,064) attached as Exhibit B and *Petkovsek* (U.S. Patent No. 5,918,802) attached as Exhibit C.
2. Would Claim 8 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention over *Main* (U.S. Patent No. 5,618,064) in view of *Petkovsek* (U.S. Patent No. 5,918,802) and further in view of *Coats et al.* (U.S. Patent No. 5,624,069). See *Coats et al.* (U.S. Patent No. 5,624,069) attached as Exhibit D.

VII. GROUPING OF CLAIMS

Appellant argues for the patentability of independent Claim 1. In addition, Appellant argues for the patentability of dependent Claim 8 separately and apart from independent Claim 1. Accordingly, Appellant argues that dependent Claim 8 does not stand or fall together with independent Claim 1.

VIII. ARGUMENT

The invention as defined in independent Claim 1 requires a mailing assembly for use in connection with the non-domestic

delivery of a mailpiece holding contents for delivery thereof having a backing sheet that forms a compartment to be adhered to the mailpiece. Claim 1 also requires a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive. The mailing form is variably printed with information necessary to comply with requirements for delivery of a non-domestic mailpiece. Claim 1 further requires a mailing form inserted into the compartment to effect non-domestic delivery of the mailpiece. Claim 1 also requires a receipt card having no adhesive backing wherein the receipt card is removably attached to the backing sheet. The receipt card is also detachably connected to the mailing form. Moreover, Claim 8 further defines a mailing assembly for use in connection with the non-domestic delivery of a mailpiece holding contents for delivery thereof having a third layer disposed on the backing sheet having an auxiliary label and further wherein the auxiliary label has an adhesive thereon.

**A. THE CITED REFERENCES AND REJECTIONS
OF CLAIMS 1-7**

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Main* (U.S. Patent No. 5,618,064) in view of *Petkovsek* (U.S. Patent No. 5,697,648).

In the Final Rejection, the Patent Office stated:

Claims 1-7 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Petkovsek*. *Main* discloses

in Fig. 1 and 2, a mailing assembly comprising: a backing sheet (200) forms a transparent compartment to be adhered to a mailpiece (Col. 2, lines 52-59) having an opening (214) wherein the form is capable of entering; a mail form (100), Col. 2, lines 60-67 and Col. 3, lines 1-3 that is removably attached to the backing sheet and further wherein the mailing sheet is variably printed with information (104-114); wherein the form is inserted into the compartment to effect delivery of the mailpiece (Col. 3, lines 11-20).

(See Final Rejection, page 3, lines 8-15 of Exhibit A of the Supplemental Appendix.)

Further, in the Final Rejection, the Patent Office stated:

However, Main does not disclose a mailing form comprised of an adhesive mailing label and a non-adhesive receipt card is removable attached to the backing sheet and is detachable connected to the mailing label.

Petkovsek discloses in Fig. 4 and 5, a mailing form (16) comprised of a removable adhesive mailing label (34, Col. 6, lines 32-40) and a non-adhesive card (18), wherein the card is removable attached to the backing sheet (14) and is detachably connected (52) to the mailing label (34).

(See Final Rejection, pages 3 and 4 of Exhibit A of the Supplemental Appendix.)

B. MAIN OR PETKOVSEK, TAKEN SINGLY OR IN COMBINATION, DO NOT TEACH CLAIMS 1-7, AND IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE THEM BY ONE HAVING ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION

With respect to the rejection of Claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Main in view of Petkovsek, Appellant respectfully submits that the claims distinctly define the present invention from Main and Petkovsek, taken singly or in

combination, for the reasons that follow.

Main teaches a packing slip and shipping label for use on a package. The packing slip has a front side having an area where a destination is contained and printed. The shipping label has a top side and a bottom side. The bottom side is adhesively coated and adhered to the backing slip. The shipping label is removed from the back side of the packing slip, and the packing slip is folded such that the destination is visible. The shipping label is affixed to the package via an adhesive coating adhered to the shipping label.

Petkovsek teaches a system for mailing an article requiring special services and a method for forming a mailpiece having an interior for carrying an article requiring special services. The system includes an integrally formed envelope and form constructed from a single sheet and folded and sealed to form an envelope and an attachment having a return postcard.

Claim 1 requires a mailing assembly for use in connection with the non-domestic delivery of a mailpiece holding contents for delivery thereof having a backing sheet that forms a compartment to be adhered to the mailpiece. Claim 1 also requires a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive. The mailing form is variably printed with information necessary to comply with requirements for delivery of a non-domestic mailpiece. Claim 1 further requires a mailing form inserted into the compartment to effect non-domestic delivery of the mailpiece. Claim

1 also requires a receipt card having no adhesive backing wherein the receipt card is removably attached to the backing sheet. The receipt card is also detachably connected to the mailing form.

Clearly, neither *Main* nor *Petkovsek*, taken singly or in combination, teach or suggest a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive. Neither *Main* nor *Petkovsek*, taken singly or in combination, teach or suggest a mailing form that is variably printed with information necessary to comply with requirements for delivery of a non-domestic mailpiece. Moreover, neither *Main* nor *Petkovsek*, taken singly or in combination, teach or suggest a receipt card without an adhesive backing wherein the receipt card is removably attached to the backing sheet. Furthermore, the Examiner admitted that *Main* does not disclose a mailing form having an adhesive mailing label and a non-adhesive receipt card, wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label.

Contrary to the assertions of the Examiner, *Petkovsek* does not teach or suggest a mailing form having a removable adhesive mailing label, and a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label. Rather, *Petkovsek* "illustrates the return postcard 18 in its position attached to the backside of the top half 14 of the assembly by the adhesive 60 from sections 54, 56 removed from the

backsides of the sections 20, 22." Therefore, neither *Main* nor *Petkovsek* teach a mailing form having a removable adhesive mailing label, a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1.

The Examiner stated that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Main*'s mailing assembly to include a mailing form having a label and card as taught by *Petkovsek* for the purpose of providing an assembly for forming a mailpiece requiring special services without additional adhesives or fixatives for attaching to the mailpiece." (See Office Action dated December 31, 2002, at page 4, lines 3-7.) Appellant submits that the structure required by the claims of the present invention clearly differs from *Main* or *Petkovsek*, taken singly or in combination.

Specifically, the mailing form defined by Claim 1 requires a removable adhesive mailing label and a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label. Therefore, Appellant submits that the mailing form of the claimed invention clearly requires defined structure in the claims that distinguishes the claimed invention from *Main* or *Petkovsek*. Moreover, the art fails to teach or suggest the specific structure defined in the claims.

Therefore, Claim 1 is patentably distinct from *Main* or *Petkovsek*.

Appellant further submits that one having ordinary skill in the art would never have been motivated to modify *Main* in view of *Petkovsek* in the manner suggested by the Examiner in formulating the rejections under 35 U.S.C. §103(a).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). No such teaching, suggestion or incentive exists in *Main* or *Petkovsek* to provide the features set forth in Appellant's invention as set forth in independent Claim 1. Therefore, one of ordinary skill in the art would not have been motivated to combine *Main* with

Petkovsek. Accordingly, the rejection of Claims 1-7 under 35 U.S.C. §103(a) should be withdrawn.

**C. THE CITED REFERENCES AND REJECTION
OF CLAIM 8**

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Main* (U.S. Patent No. 5,618,064) in view of *Petkovsek* (U.S. Patent No. 5,697,648) and further in view of *Coats et al* (U.S. Patent No. 5,624,069).

In the Final Rejection, the Patent Office stated:

Main as modified by Petkovsek discloses a mailing assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Main does not disclose a third auxiliary label on the backing sheet.

Coats et al discloses in Fig. 3, a mailing assembly comprising a backing sheet (11) forming an envelope (A and B) formed via the adhesive layer and adhered to a mailing form (37), and a third layer (Col. 5, lines 50-56) being an identification label disposed on the surface (25) of the backing sheet (11).

(See Final Rejection, pages 4 of Exhibit A of the Supplemental Appendix.)

D. MAIN, PETKOVSEK, OR COATS ET AL., TAKEN SINGLY OR IN COMBINATION, DO NOT TEACH CLAIM 8, AND IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE THEM BY ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Petkovsek* and further in view of *Coats et al.* Appellant respectfully submits that Claim 8

distinctly defines the present invention from *Main*, *Petkovsek* or *Coats et al.*, taken singly or in combination, for the reasons that follow. Further, this rejection is respectfully traversed in view of the arguments set forth above with respect to Claim 1 and for the reasons set forth below.

Coats et al. fail to teach a mailing assembly having a removably adhesive mailing label and a receipt card wherein the receipt card has no adhesive backing and further wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1 of the present invention. Moreover, *Coats et al.* fail to teach a mailing assembly having a third layer disposed on the backing sheet having an auxiliary label and further wherein the auxiliary label has an adhesive thereon as required by Claim 8 of the present invention.

Moreover, one of ordinary skill in the art would never have been motivated to combine *Main* and *Petkovsek* with *Coats et al.* in the manner suggested by the Examiner in formulating the rejection under 35 U.S.C. §103. In fact, the Examiner completely failed to establish a *prima facie* case of obviousness in rejecting Claim 8 under 35 U.S.C. §103(a) as being unpatentable in view of the combination of *Main*, *Petkovsek* and *Coats et al.* No such teaching, suggestion or incentive exists in *Main*, *Petkovsek* and *Coats et al.* to combine *Main* and *Petkovsek* with *Coats et al.* Therefore, one of ordinary skill in the art would not have been motivated to combine

Main and Petkovsek with Coats et al.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). No such teaching, suggestion or incentive exists in Main, Petkovsek or Coats et al. to provide the features set forth in Appellant's invention. Therefore, one of ordinary skill in the art would not have been motivated to combine Main, Petkovsek and Coats et al.

Still further, Appellant submits that the Examiner is merely "piece-mealing" references together providing various teachings and positively defined limitations of Appellant's mailing assembly to deprecate the claimed invention. Of course, hindsight reconstruction of Appellant's invention is impermissible. Since no suggestion exists to combine *Main*, *Petkovsek* and *Coats et al.*, the Examiner cannot arbitrarily do so to reject the claims. Instead, a reason is required why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975).

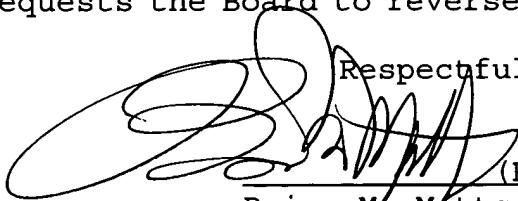
The court in *In re McLaughlin* stated "[T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 USPQ 2d 1248, 1250 (Fed. Cir. 19789). Since the Examiner has failed to establish a *prima facie* case of obviousness in combining *Main* and *Petkovsek* with *Coats et al.*, the rejection of Claim 8 under 35 U.S.C. §103(a) is improper.

CONCLUSION

For the foregoing reasons, Appellant respectfully submits that the rejections of Claims 1-8 are erroneous as a matter of law and fact and respectfully requests the Board to reverse the rejections.

Respectfully submitted,



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- 1) APPENDIX: Claims 1-8
- 2) SUPPLEMENTAL APPENDIX

EXHIBIT A: Final Rejection
EXHIBIT B: Main (U.S. Patent No. 5,618,064)
EXHIBIT C: Petkovsek (U.S. Patent No. 5,918,802)
EXHIBIT D: Coats et al (U.S. Patent No. 5,624,069)

APPENDIX

1. A mailing assembly for use in connection with a non-domestic delivery of a mailpiece holding contents for delivery thereof, the assembly comprising:

a backing sheet wherein the backing sheet forms a compartment to be adhered to the mailpiece;

a mailing form having a mailing label and a receipt card wherein the mailing label is removably attached to the backing sheet by an adhesive and further wherein the mailing form is variably printed with information necessary to comply with requirements for delivery of the mailpiece wherein the mailing form is inserted into the compartment to effect non-domestic delivery of the mailpiece and further wherein the receipt card has no adhesive backing and wherein the receipt card is removably attached to the backing sheet and is detachably connected to the mailing label.

2. The mailing assembly of Claim 1 further comprising:

an adhesive layer on the backing sheet.

3. The mailing assembly of Claim 2 wherein the adhesive layer is between the mailing form and the backing sheet.

4. The mailing assembly of Claim 2 wherein the compartment formed from the backing sheet is capable of adhering to the mailpiece via the adhesive layer.

5. The mailing assembly of Claim 2 wherein the compartment formed from the backing sheet is capable of being formed via the adhesive layer.

6. The mailing assembly of Claim 1 wherein the compartment formed from the backing sheet is transparent.

7. The mailing assembly of Claim 1 further comprising:

an opening in the compartment wherein the mailing form is capable of entering therethrough.

8. The mailing assembly of Claim 1 further comprising:

a third layer disposed on the backing sheet having an auxiliary label and further wherein the auxiliary label has an adhesive thereon.

SUPPLEMENTAL APPENDIX

Office Action Summary

Application No.

09/487,696

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

Art Unit

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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 October 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 and 21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 9-16 is/are allowed.

6) Claim(s) 1-8 and 21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The amendment in Paper No. 10 has been entered.

Claims 1 and 9 have been amended for further examination. Claims 17-20 have been canceled. Claim 21 has been added for examination.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Petkovsek (5,918,802).

Main discloses in Fig. 1 and 2, a mailing assembly comprising: a backing sheet (200) forms a transparent compartment to be adhered to a mailpiece (Col. 2, lines 52-59) having an opening (214) wherein the form is capable of entering); a mail form (100, Col. 2, lines 60-67 and Col. 3, lines 1-3) that is removably attached to the backing sheet and further wherein the mailing sheet is variably printed with information (104-114); wherein the form is inserted into the compartment to effect delivery of the mailpiece (Col. 3, lines 11-20).

However, Main does not disclose a mailing form comprised of an adhesive mailing label and a non-adhesive receipt card, wherein the receipt card is removable attached to the backing sheet and is detachably connected to the mailing label.

Petkovsek discloses in Fig. 4 and 5, a mailing form (16) comprised of a removable adhesive mailing label (34, Col. 6, lines 32-40) and a non-adhesive card (18), wherein the card is

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removable attached to the backing sheet (14) and is detachably connected (52) to the mailing label (34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Main's mailing assembly to include a mailing form having a label and card as taught by Petkovsek for the purpose of providing an assembly for forming a mailpiece requiring special services without additional adhesives or fixatives for attaching to the mailpiece.

3. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Petkovsek and further in view of Coats et al (5,624,069).

Main as modified by Petkovsek discloses a mailing assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Main does not disclose a third auxiliary label on the backing sheet.

Coats et al discloses in Fig. 3, a mailing assembly comprising a backing sheet (11) forming an envelope (A and B) formed via the adhesive layer and adhered to a mailing form (37), and a third layer (Col. 5, lines 50-56) being an identification label disposed on the surface (25) of the backing sheet (11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Main's and Petkovsek's mailing assembly to include a third

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layer disposed on the backing layer comprising an auxiliary label as taught by Coats et al for the purpose of providing an identification mechanism for the mailing assembly.

4. Claim 21 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Main in view of Coats et al (5,624,069).

Main discloses in Fig. 1 and 2, a mailing assembly comprising all the elements as claimed in Claim 1, and as set forth above.

However, Main does not disclose: wherein the backing sheet forms an envelope having a compartment, and wherein the mailing form is sub-divided into a plurality of printed sub-parts.

Coats et al discloses in Fig. 3, a mailing assembly comprising a backing sheet (11) forming an envelope (A and B) formed via the adhesive layer and adhered to a mailing form (37) having printed sub-parts.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mains's mailing assembly and replace the compartment with an envelope forming a compartment as taught by Coats et al for the purpose of providing a more secured compartment structure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia on the sub-parts such as variably printed information, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally

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related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. The sub-parts of coats et al are capable of being printed with mailing requirement information depending on what the end user wishes to place on the sub-parts

Allowable Subject Matter

5. Claims 9-16 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a mailing assembly comprising: a backing sheet which forms an envelope with a compartment that is adhered to a mailpiece; a mailing form that is removably attached to the backing sheet and is subdivided into a plurality of sub parts, wherein each sub-part is variably printed with information; and further wherein at least one sub-part is inserted into the compartment; and including all of the other limitations of the independent claim.

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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Petkovsek ('129) discloses a mailing assembly comprising a mailing form and backing sheet.

Response to Arguments

7. Applicant's arguments with respect to claims 1-16 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



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